

08/646 213



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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/646,213 05/07/96 AFANASENKO

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EXAMINER

F3M1/1121

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MARKSHEET J PAPER NUMBER

16

3302
DATE MAILED:

11/21/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on May 7, 1996 and September 18, 1996

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 7-10 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 7-10 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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Claim Rejections - 35 USC § 112

1. Claims 7-10 are rejected as failing to define the invention in the manner required by 35 U.S.C. § 112, second paragraph.

In regard to claims 7 and 8, the functional recitation that the supports are "installed" or "placed" on the patient and that the elastic tie-members are "arranged in antagonistic pairs relative to the joints" or "being disposed on the patient's trunk with due account of their position relative to the spine ..." is indefinite because it is not supported by recitation in the claim of sufficient structure to accomplish the function. Furthermore, the claims at issue describe the invention in terms of a particular user. Therefore, whether a device falls within the scope of the claims cannot be ascertained until a particular user engages the device. Consequently, the claims are indefinite. Ex parte Brummer, 12 USPQ2d 1653 (BdPatApp & Inter 1989).

In regard to claim 7, the claim is unclear to what the phrase "pelvic supports" are referring to in the specification and drawings since only a single pelvic support is disclosed. Also, the antecedent basis for "said supports" (line 11) is unclear. Is the phrase referring to the pelvic supports, the foot supports or both? Clarification is requested. Furthermore, the phrase "provides the fixing of joints in a required position" (lines 11-12) seems to contradict the following phrase "does not

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prevent the flexure, extension, abduction of the limbs and movements of the trunk...." How can the joint position be "fixed" without preventing movement of the joint? Clarification is requested.

In regard to claim 9, the claim is unclear if it is citing a "lock" for each adjusting means or whether there is only one lock. Clarification is requested. Claim 10 necessarily rejected as being based on a rejected claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bradstreet.

In regard to claim 7, Bradstreet teaches a device comprising a pelvic support 3, foot supports (D) and elastic tie-members 4,5,8,11,14,20,21,23 and 27 arranged in "antagonistic pairs" and connected to at least two supports (Figures 1,2, page 1 lines 8-34 and page 2 lines 69-79). **In regard to claim 8**, see the rejection of claim 7 since the claims cite similar

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subject matter. Additionally, Bradstreet teaches shoulder supports 7, hand supports 13, elbow supports 12 and knee supports 22. Bradstreet teaches a device that develops "practically every muscle of the body" wherein the elastic members are located anteriorly and posteriorly on the trunk and limbs.

While anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure *in haec verba*. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). In addition, it does not require that the prior art reference "teach" what the application at issue teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). Finally, Applicant is reminded that during examination claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Where the preambular language is part of the definition of the invention, it provides a limitation. Diversitech Corp. v. Century Steps Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988). Where, however, the preambular language states a purpose or intended use for the invention, it is not a limitation, but merely an indication of a possible use or the environment in which the invention operates.

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Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 228 USPQ 90 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradstreet in view of Wilkinson.

In regard to claim 9, Bradstreet teaches a plurality of means (A) for adjusting the tension (Figure 6 and page 1 lines 74-81). Bradstreet discloses the claimed invention except for the lock connecting each adjusting means to the support at one end. Wilkinson teaches that it is known to provide such a lock 120 as set forth at column 5, lines 27-34 (Figure 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a lock, as taught by Wilkinson in order to provide a convenient means for disconnecting the elastic members from the support. **In regard to claim 10**, the lock is essentially a conventional buckle.

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Response to Amendment

6. The new matter rejection pertaining to the buckle is withdrawn since applicant cancelled the subject matter comprising the new matter. Furthermore, the applicant should note that in the advisory action (paper no. 10) the arrangement of the elastic tie-members was not rejected as being new matter. The new claims citing the arrangement were not entered because it introduced new **issues** that were never previously claimed.

7. The declarations and exhibits under 37 CFR 1.132 filed September 18, 1996 is insufficient to overcome the rejection of claims 7-10 because: The declarations are drawn to the METHOD of USING the device called "Adeli" and its effects. However, the claims are drawn towards an apparatus and not the method of use. Claims cannot be distinguished over prior art teaching the same structural elements merely because applicant has discovered a new USE for the claimed apparatus. While anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure *in haec verba*. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). In addition, it does not require that the prior art reference "teach" what the application at issue teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stevens - note the buckle (Figures 3,6).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeanne Clark whose telephone number is (703) 308-0063.

J Clark
November 19, 1996


JEANNE M. CLARK
PATENT EXAMINER
GROUP 3300